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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,065	07/13/2000	Norman Understein	2802-5 (AMK)	7218
23117 7590 09/27/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER GREENE, DANIEL LAWSON	
			ART UNIT	PAPER NUMBER
			3694	
			MAIL DATE	DELIVERY MODE
			09/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/617,065

Applicant(s)

UNDERSTEIN, NORMAN

Examiner

Daniel L. Greene Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Reopening Prosecution After Filing of Appeal Brief**

1. In view of the Appeal Brief filed on 6/13/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth here below.
2. To avoid abandonment of the application, Appellant must exercise one of the following two options:
  - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office Action is final); or,
  - (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37.
3. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellants' must pay the difference between the increased fees and the amount previously paid.
4. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing at the end of this Office Action.
5. The previous Non-Final Office Action mailed 1/30/2007 is hereby withdrawn in view of the new ground(s) of rejection. Any inconvenience to applicant is regretted.
6. Applicant's arguments within said appeal brief have been fully considered and they are persuasive. NOT because the '396 Walker patent does not disclose the information, but because the material that was incorporated by reference in said '396 patent, i.e. the '207 Walker patent (see Col. 1 lines 9-15 of '396) were not explicitly set

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forth in the previous Office action. Although the specific limitations applicant alleges are not explicitly within the '396 patent, they are implicitly therewithin due to their incorporation by reference. However to maintain a clear prosecution history the Examiner has reconsidered the '207 Walker patent and provides specific locations wherein the explicit limitations are found.

7. Accordingly an action on the merits of claims 1-9 follows.

8. **Examiner's Note:** The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,794,207 to Walker et al.**

Walker clearly sets forth a method of qualifying a participant over a global network in a transaction requiring a transfer of funds from the participant using a qualifying system (see for example, the ABSTRACT), the method comprising:

(a) the participant establishing a consumer funding account by depositing funds in the consumer funding account, the consumer funding account to be administered by the qualifying system (see for example, Col. 9 lines 31-40 and Columns 21 and 22);

(b) the participant entering a transaction requiring a transfer of funds from the participant to a vendor (see for example, Col. 16 lines 62+);

(c) the qualifying system reserving a portion of the consumer funding account according to a transaction parameter determined by at least one of the qualifying system, the participant or the vendor (see for example, Col. 17 lines 34-35); and

(d) the qualifying system qualifying the participant for the transaction if the consumer funding account satisfies conditions of the transaction parameter, (see for example, Col. 17 lines 27-47).

**Regarding claim 2** and the limitation wherein the transaction parameter is a required deposit, see for example, Col. 7 lines 47-50, Col 22 lines 20-23, etc.

**Regarding claim 3** and the limitation wherein the transaction parameter is an amount of funds required to complete the transaction see for example, Col. 7 lines 47-50, Col 22 lines 20-23, etc.

**Regarding claim 4** and the method of qualifying a participant over a global network in a transaction requiring a transfer of funds from the participant using a qualifying system, the method comprising:

- (a) the participant establishing a consumer funding account by depositing funds in the consumer funding account, the consumer funding account to be administered by the qualifying system,

- (b) the participant entering a transaction requiring a transfer Of funds from the participant to a vendor;

- (c) the qualifying system reserving a portion of the consumer funding account according to a transaction parameter determined by at least one of the qualifying system, the participant or the vendor, wherein step (c) is practiced by reserving a first portion of the consumer funding account corresponding to a required deposit and reserving a second portion of the consumer funding account corresponding to an amount of funds required to complete the transaction and

- (d) the qualifying system qualifying the participant for the transaction if the consumer funding account satisfies conditions of the transaction parameter.

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**Regarding claim 5** and the limitation releasing the reserved portion of the consumer funding account when the transaction is completed, see for example, col. 22 lines 20-23, Col. 20 line 49 through Col. 23 line 5, ESPECIALLY COL. 20 "THESE PAYMENT METHODS ARE MEANT TO BE MERELY ILLUSTRATIVE, HOWEVER , AS THERE ARE MANY EQUIVALENT PAYMENT METHODS COMMONLY KNOWN IN THE ART WHICH MAY BE USED".

**Regarding claim 6** and the limitation wherein step (c) is practiced by querying a network website server that maintains the consumer funding account, see for example, Col. 10 lines 8-17.

**Walker clearly discloses claims 7 and 8**, i.e. a computer system and computer program embedded on a medium for effecting qualifying of a participant over a global network in a transaction requiring a transfer of funds from the participant to a vendor, the computer system comprising: at least one user computer running a computer program that requests information according to a transaction inquiry input by the participant; and a system server running a server program, the at least one user computer and the system server being interconnected by a computer network, the system server determining whether the participant has established a consumer funding account by depositing funds in the consumer funding account, and if the participant has established the consumer funding account, the system server reserving a portion of the consumer funding account

according to a transaction parameter determined by at least one of the system server, the participant or the vendor, wherein the system server administers the consumer funding account, and wherein the system server qualifies the participant for the transaction if the consumer funding account satisfies conditions of the transaction parameter., in the rejection of corresponding parts above as well as Col. 17 lines 53+, Col. 10n lines 8-17, etc.

**Walker clearly discloses claim 9**, i.e. a method of qualifying a participant over a global network in a transaction requiring a transfer of funds from the participant using a qualifying system, the method comprising:

- (a) the participant entering a transaction requiring a transfer of funds from the participant to a vendor;
- (b) the qualifying system determining whether the participant has established a consumer funding account, wherein if the participant has not established the consumer funding account, the qualifying system providing the participant an opportunity to establish the consumer funding account, the consumer funding account to be administered by the qualifying system (see for example, Col. 8 line 67 through Col. 9 line 5 and Col 13 lines 1-10);
- (c) after establishing the consumer funding account, the qualifying system continuing with the transaction;



- (d) the qualifying system reserving a portion of the consumer funding account according to a transaction parameter determined by at least one of the qualifying system, the participant or the vendor; and
- (e) the qualifying system qualifying the participant for the transaction if the consumer funding account satisfies conditions of the transaction parameter in the rejection of corresponding parts of claims 1 and 4 above.

**11. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 6,240,396 B1 to Walker et al.**

'396 Walker incorporates the '207 Walker patent by reference in the first paragraph found in Col. 1 lines 5-15, therefore claims 1-9 are rejected for AT LEAST the same reasons given above in section 10.

Regarding claim 5, If applicant is of the opinion that the '207 Walker patent does not inherently include said limitation, then resort may be had to '369, Col. 8 lines 10-15 to show it is known in the art to reserve portions of accounts during transactions and refund said reservation once the transaction has been completed.


***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Thur.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG   
2007-09-20

  
ELIA COLBERT  
PRIMARY EXAMINER